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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Hal A. Lewis	Confirmation No. 9298
Serial No.: 09/729,838	Group Art Unit: 1631
Filed: December 4, 2000	Examiner: Channing Mahatan
For: CRYSTALS AND STRUCTURE OF LUXS	Attorney Docket No.: 10342-012-999

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants have carefully considered the Restriction Requirement mailed June 3, 2003, in connection with the above-captioned application. Reconsideration of the Restriction Requirement under 37 C.F.R. § 1.143 in light of the remarks that follow is respectfully requested. Accompanying this Response is a Petition for Extension of Time under 37 C.F.R. § 1.136(a) to extend the period of response by two months, to and including **September 3, 2002**.

REMARKS

In response to the Restriction Requirement, Applicants elect to prosecute the claims of Group I, Claims 1-42, drawn to a crystal, a method of making the crystal and a machine-readable medium embedded with the information that corresponds to a three-dimensional representation of the crystal. Applicants traverse the PTO's further Sequence Election Requirement Applicable to Groups I-III.

Alleging that a particular claim represents multiple "patentably distinct" inventions in a restriction requirement is a *de facto* rejection of the patentability of the claim, because the restricted claim cannot issue as drafted. Under the controlling legal standard, restriction under 35 U.S.C. § 121 of the subject matter of a single claim is improper and impermissible. The Court of Customs and Patent Appeals extensively discussed and decided this issue in *In re Weber, Soder, and Boksay*, 198 U.S.P.Q. 328 (C. C. P. A., 1978) ("*Weber*"). In that case, the Court stated that

> [a]s a general proposition, an applicant has the right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action

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